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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,305	03/12/2004	Takahiro Kume	742158-9	5795
22204	7590	06/15/2006	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/798,305

Applicant(s)

KUME ET AL.

Examiner

Victor S. Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 4-8 and 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 4/20/2006. Applicants' amendment to claim 1 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Election/Restrictions

4. Applicants' statement "... 37 C.F.R. 1.141 and MPEP 806.04(d) and 821.04 ... instruct the examiner to rejoin and allow any withdrawn claims, which recite all the limitations of an allowable generic claim" (Remarks, page 6) is acknowledged.

Claim Rejections - 35 USC § 112

5. Claims 1-3 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Despite a substantial amendment to claim 1, the Examiner notes that claim 1 is still generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

In particular, at lines 9-12, the amended recitation “said foams formed at the polishing layer having a space volume larger than that of foams formed at the surface layer and said foams formed at the polishing layer communicating to form a network of continuous holes whose diameter is smaller than a diameter of the space volume of the foams formed at the polishing layer” ... diameter is smaller than that of the space volume” is vague, indefinite and confusing. First, the recitation “said foams formed at the polishing layer having a space volume larger than that of foams formed at the surface layer and said foams formed at the polishing layer” appears erroneous, because it is like saying A is greater than A+B, when inherently both A and B are greater than 0. Second, the recitation “said foams formed at the polishing layer communicating to form a network of continuous holes” is vague, indefinite and confusing. Specifically, it is unclear how “said foams” is able to “communicate” or move to form holes? Does it mean a porous structure having open cells? Third, the recitation “holes whose diameter is smaller than a diameter of the space volume of the foams formed at the polishing layer” is also vague, indefinite and confusing, because it is unclear how a “diameter” (a linear dimension) can be compared to a “space volume” (a 3D dimension). Clarifications and corrections are requested.

Rejections Based on Prior Art

6. Claims 1-3 and 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 10-249709 (abstract), and evidenced by Applicants’ admission.

JP ‘709 is directed to an abrasive cloth (polishing sheet) having a urethane resin film of a vertical foam structure (foam with grooves, see Figure) formed by uniformly coating a flat sheet

with a urethane resin liquid, then solidifying (coagulating) the liquid by a wet solidification method. Further, JP '709 expressly teaches that the vertical foam structure is homogeneous, i.e., uniform (abstract).

JP '709 is silent about the formation of a skin layer, the thickness of the polishing layer, and the porous structure relations within and between the skin layer and the polishing layer. However, the Examiner asserts that these features are old and well known to one of ordinary skill in the art of wet film forming process, as evidenced by Applicants' admission that in conventional wet film forming process, a skin layer is formed, and the coagulation liquid enters into an interior of the resin emulsion from portions where the coagulation liquid is easy to enter at the skin layer, i.e., pores are communicated (specification, paragraph 0039). As such, since JP '709 teaches the same subject matter (a pad), formed by the same process (wet film forming process), and for the same use (polishing), in the absence of evidence to the contrary, it is the Examiner's position that the aforementioned limitations are either anticipated by JP '709, or obviously provided by practicing the invention of prior art.

Response to Argument

7. With respect to Applicants' argument "substantially almost round and not large cells 3 are formed in the polyurethane sheet 2 as shown in Fig. 1 ... In contrast, the foams formed in the urethane sheet obtained by the '709 ... have a foam length almost as long as a thickness thereof ... These foams are large cells." (Remarks, page 7), the Examiner respectfully reminds Applicants that the shape and size of the cells are absent from the claims, and it fails to exclude

the teachings of JP '709. In other words, JP '709 anticipates and/or renders obvious the instant invention as claimed.

Finally, Applicants argument "... the manufacturing methods among the present invention, the '709 abstract, and the conventional pad are different from one another ... the method described in the '709 abstract would not necessarily result in an elastic plastic foam sheet ... in ... claim 1." (Remarks, pages 9-10) has been carefully considered, but is not persuasive. The instant claims are not so limited as to be distinguishable from the method or product set forth in JP '709, i.e., the current language is too general to support Applicants' argument, and the current claims are still seen to encompass the teachings of JP '709.

Conclusion

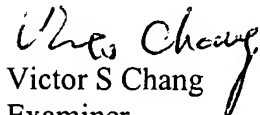
8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Victor S Chang
Examiner
Art Unit 1771

6/1/2006



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